

Serial No. 10/587,111
Art Unit 2482
Brief on Appeal

PU030288
Customer No. 24498

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicants:	John W. Richardson et al.	Serial No.:	10/587,111
Art Unit:	2482	Examiner:	Hee-Yong Kim
Filed	July 24, 2006	Confirmation No.:	9520

For: STORAGE OF ADVANCED VIDEO CODING (AVC) PARAMETER SETS IN AVC
FILE FORMAT

Commissioner for Patents
MAIL STOP –Appeal Brief – Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REPLY BRIEF

Applicants hereby submit this reply brief to address the arguments made in the
examiner's answer mailed July 26, 2011.

RESPONSE TO THE EXAMINER'S ANSWER

In paragraph (10) of the examiner's answer regarding the rejection of claims 25, 32, 34, 36, 43 and 45, the examiner acknowledges that neither of the Jones et al. and Visharam et al references alone discloses applicants' feature of embedding the parameter information in a Session Description Protocol (SDP) payload of a hint track of the file. However, the examiner alleges that the combination of Jones et al. and Visharam et al. teach this feature. Applicants do not understand how the examiner can admit that none of the references teaches this feature, but nonetheless argue that the combination of references does so.

Applicants submit that Jones et al. teaches the inclusion of SDP information in user atoms in the hint track. Assuming arguendo that the examiner is correct that SDP has a header and a payload capable of carrying embedded information, the Jones et al. patent still says nothing regarding the desirability of embedding parameter information in the SDP payload.

Applicant has previously discussed the Visharam et al. published application and reiterate, that like Jones et al., Visharam et al. says very little regarding SDP. At best, Visharam states that a decoder can use the SDP protocol to signal its ability to provide the capabilities described the SEI message. [See paragraph 0172 of Visharam et al.] The signaling described in Visharam et al. constitutes an operation entirely different than embedding parameters in the SDP payload.

Applicants acknowledge that Visharam et al. disclose the desirability of including parameter set metadata into a file associated with the media data using a specific media file format. (See step 812 in FIG. 8 and paragraph [0094] of Visharam et al.). However, this disclosure does not teach or suggest applicants' feature of embedding the parameter information in a Session Description Protocol (SDP) payload of a hint track of the file. Clearly, Visharam et al. had knowledge of SDP by virtue of the brief mention made of this protocol at paragraph [0172] of their published application. However, Visharam et al. contains no suggestion of the desirability of embedding the parameter information in the SDP by virtue of absence of any mention of the SDP in connection with discussion in connection with parameter embedding.

Only by use of impermissible hindsight to applicants' own disclosure can the examiner claim that Visharam et al. suggest embedding the parameter information in the SDP.

The failure of an asserted combination to teach or suggest each and every feature of a claim remains fatal to an obviousness rejection under 35 U.S.C. § 103. Section 2143.03 of the MPEP requires the "consideration" of every claim feature in an obviousness determination. To render a claim unpatentable, however, the Office must do more than merely "consider" each and every feature for this claim. Instead, the asserted combination of the patents must also teach or suggest *each and every claim feature*. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). Indeed, as the Board of Patent Appeal and Interferences has recently confirmed, a proper obviousness determination requires that an Examiner make "a searching comparison of the claimed invention - *including all its limitations* - with the teaching of the prior art." See *In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original). "If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious" (MPEP §2143.03, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

As discussed above, neither of Jones et al. and Visharam teach or suggest applicants' claimed feature of embedding the parameter information in a Session Description Protocol (SDP) payload of a hint track of the file. In the absence of such a teaching in either reference, the examiner cannot maintain that the combination of these references renders obvious applicants' claims 25, 32, 34, 36, 43, and 45. For this reason, applicants request reversal of the 35 U.S.C. § 103(a) rejection of these claims.

Claims 28-31, 33, and 39-42 depend from independent claims that recite the feature of embedding the parameter information in a Session Description Protocol (SDP) payload of a hint track of the file. Neither US Published Application 2005/0004968 in the name of Jari Mononen et al. cited with regard to claims 28 and 39 nor the publication MPEG 2001/N4858 publication cited with respect to claims 29-31, 33, 40-42 and 44 teaches or suggests the feature of embedding the parameter information in a Session Description Protocol (SDP) payload of a hint track of the

Serial No. 10/587,111
Art Unit 2482
Brief on Appeal

PU030288
Customer No. 24498

file. Therefore dependent claims 28-31, 33, and 39-42 patentably distinguish over the art of record, warranting reversal of the 35 U.S.C. § 103(a) rejection of these claims.

Respectfully submitted,
John W. Richardson et al.

By: /Robert B. Levy/
Robert B. Levy, Attorney for Applicants
Reg. No. 28,234

Patent Operations
Thomson Licensing LLC
P.O. Box 5312
Princeton, New Jersey 08543-5312
Date: June 23, 2011